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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,396	05/01/2004	Elie Seidman	EPNA.P-002	1792
57380	7590	09/27/2006	EXAMINER	
OPPEDAHL & OLSON LLP			LE, UYEN CHAU N	
P.O. BOX 4850			ART UNIT	
FRISCO, CO 80443-4850			PAPER NUMBER	
			2876	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/709,396

Applicant(s)

SEIDMAN, ELIE

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/21/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Preliminary Amendment filed 11/25/2005.

Claim Objections

2. Claims 1, 2, 5, 7, 9-11, 14, 16, 18-20, 23, 26, 29-31, 34, 37, 40-42, 45, 47, 49-51, 54, 56 and 58 are objected to because of the following informalities:

Re claim 1, line 4: Substitute "its" with -- said first card's --

.

Re claim 1, line 7: Substitute "its" with -- said second card's -

--.

Re claim 1, line 8: Substitute "its" with -- said second card's -

--.

Re claim 1, line 10: Substitute "its" with -- said second card's

--.

Re claim 1, line 15: Substitute "its" with -- said first card's -

--.

Re claim 2, line 1: Substitute "its" with -- said first card's --

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Re claim 2, line 3: Substitute "its" with -- said first card's --

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Re claim 5, line 4: Substitute "its" with -- said first card's --

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Re claim 5, line 7: Substitute "its" with -- said second card's -

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Re claim 5, line 8: Substitute "its" with -- said second card's -

-.

Re claim 5, line 10: Substitute "its" with -- said second card's

--.

Re claim 7, line 6: Substitute "its" with -- said first card's --

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Re claim 7, line 8: Substitute "its" with -- said second card's -

-.

Re claim 7, line 11: Substitute "its" with -- said second card's

--.

Re claim 7, line 13: Substitute "its" with -- said --.

Re claim 9, line 5: Substitute "its" with -- said first card's --

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Re claim 9, line 7: Substitute "its" with -- said second card's -

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Re claim 9, line 9: Substitute "its" with -- said second card's -

-.

Re claim 9, line 10: Substitute "its" with -- said second card's

--.

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Re claim 9, line 13: Substitute "its" with -- said first one's --

Re claim 9, line 15: Substitute "its" with -- said second one's -

Re claim 10, line 4: Substitute "its" with -- said first card's -

Re claim 10, line 6: Substitute "its" with -- said second card's

Re claim 10, line 8: Substitute "its" with -- said second card's

Re claim 10, line 9: Substitute "its" with -- said second card's

Re claim 10, line 15: Substitute "its" with -- said --.

Re claim 11, line 1: Substitute "its" with -- said first card's -

Re claim 11, line 3: Substitute "its" with -- said --.

Re claim 14, line 6: Substitute "its" with -- said second card's

Re claim 14, line 8: Substitute "its" with -- said second card's

Re claim 14, line 9: Substitute "its" with -- said second card's

Re claim 16, line 5: Substitute "its" with -- said first card's -

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Re claim 16, line 8: Substitute "its" with -- said second card's
--.

Re claim 16, line 10: Substitute "its" with -- said second card's
--.

Re claim 18, line 4: Substitute "its" with -- said first card's -
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Re claim 18, line 7: Substitute "its" with -- said second card's
--.

Re claim 18, line 9: Substitute "its" with -- said second card's
--.

Re claim 18, line 10: Substitute "its" with -- said second card's
--.

Re claim 19, line 4: Substitute "its" with -- said first card's -
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Re claim 19, line 6: Substitute "its" with -- said second card's
--.

Re claim 19, line 7: Substitute "its" with -- said second card's
--.

Re claim 19, line 9: Substitute "its" with -- said second card's
--.

Re claim 19, line 14: Substitute "its" with -- said --.

Re claim 20, line 1: Substitute "its" with -- said first card's -
-.

Re claim 20, line 3: Substitute "its" with -- said --.

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Re claim 26, line 6: Substitute "its" with -- said first card's -

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--.

Re claim 26, line 7: Substitute "its" with -- said second card's

--.

Re claim 26, line 9: Substitute "its" with -- said second card's

--.

Re claim 26, line 11: Substitute "its" with -- said second card's

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Re claim 26, line 13: Substitute "its" with -- said --.

Re claim 29, line 5: Substitute "its" with -- said first card's -

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--.

Re claim 29, line 8: Substitute "its" with -- said second card's

--.

Re claim 29, line 10: Substitute "its" with -- said second card's

--.

Re claim 29, line 12: Substitute "its" with -- said second card's

--.

Re claim 29, line 14: Substitute "its" with -- said --.

Re claim 30, line 4: Substitute "its" with -- said first card's -

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--.

Re claim 30, line 5: Substitute "its" with -- said second card's

--.

Re claim 30, line 7: Substitute "its" with -- said second card's

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Re claim 30, line 9: Substitute "its" with -- said second card's

--.

Re claim 30, line 14: Substitute "its" with -- said --.

Re claim 31, line 3: Substitute "its" with -- said --.

Re claim 34, line 4: Substitute "its" with -- said first card's -

--.

Re claim 34, line 5: Substitute "its" with -- said second card's

--.

Re claim 34, line 7: Substitute "its" with -- said second card's

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Re claim 34, line 8: Substitute "its" with -- said second card's

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Re claim 37, line 5: Substitute "its" with -- said first card's -

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Re claim 37, line 7: Substitute "its" with -- said second card's

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Re claim 37, line 9: Substitute "its" with -- said second card's

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Re claim 37, line 10: Substitute "its" with -- said second card's

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Re claim 40, line 4: Substitute "its" with -- said first card's -

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Re claim 40, line 6: Substitute "its" with -- said second card's

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Re claim 40, line 8: Substitute "its" with -- said second card's

--.

Re claim 40, line 9: Substitute "its" with -- said second card's

--.

Re claim 41, line 4: Substitute "its" with -- said jacket's --.

Re claim 41, line 6: Substitute "its" with -- said card's --.

Re claim 41, line 7: Substitute "its" with -- said card's --.

Re claim 41, line 9: Substitute "its" with -- said card's --.

Re claim 41, line 16: Substitute "its" with -- said --.

Re claim 42, line 1: Substitute "its" with -- said jacket's --.

Re claim 42, line 3: Substitute "its" with -- said --.

Re claim 45, line 3: Substitute "its" with -- said jacket's --.

Re claim 45, line 6: Substitute "its" with -- said card's --.

Re claim 45, line 7: Substitute "its" with -- said card's --.

Re claim 47, line 5: Substitute "its" with -- said jacket's --.

Re claim 47, line 7: Substitute "its" with -- said card's --.

Re claim 47, line 9: Substitute "its" with -- said card's --.

Re claim 47, line 14: Substitute "its" with -- said --.

Re claim 49, line 5: Substitute "its" with -- said jacket's --.

Re claim 49, line 8: Substitute "its" with -- said card's --.

Re claim 49, line 9: Substitute "its" with -- said card's --.

Re claim 49, line 11: Substitute "its" with -- said card's --.

Re claim 49, line 15: Substitute "its" with -- said --.

Re claim 49, line 17: Substitute "its" with -- said --.

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Re claim 50, line 4: Substitute "its" with -- said jacket's --.

Re claim 50, line 6: Substitute "its" with -- said card's --.

Re claim 50, line 7: Substitute "its" with -- said card's --.

Re claim 50, line 9: Substitute "its" with -- said card's --.

Re claim 50, line 15: Substitute "its" with -- said --.

Re claim 51, line 1: Substitute "its" with -- said jacket's --.

Re claim 51, line 3: Substitute "its" with -- said --.

Re claim 54, line 3: Substitute "its" with -- said jacket's --.

Re claim 54, line 6: Substitute "its" with -- said card's --.

Re claim 54, line 7: Substitute "its" with -- said card's --.

Re claim 54, line 8: Substitute "its" with -- said card's --.

Re claim 56, line 5: Substitute "its" with -- said jacket's --.

Re claim 56, line 7: Substitute "its" with -- said card's --.

Re claim 56, line 9: Substitute "its" with -- said card's --.

Re claim 56, line 10: Substitute "its" with -- said card's --.

Re claim 58, line 4: Substitute "its" with -- said jacket's --.

Re claim 58, line 6: Substitute "its" with -- said card's --.

Re claim 58, line 8: Substitute "its" with -- said card's --.

Re claim 58, line 9: Substitute "its" with -- said card's --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-6, 10, 12-15, 19, 21-25, 30, 32-36, 41, 43-46, 50 and 52-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (US 6269158 B1).

Re claims 1, 3-6, 10, 12-15, 19, 21-25, 30, 32-36, 41, 43-46, 50 and 52-55: Kim discloses a method performed with respect to an instrument, the instrument having a perforation joining a first card 15 and a second card 20, each of the first card 15 and second card 20 having an obverse and a reverse side, the first card 15 having a hook opening 14 and bearing on both obverse and reverse sides indicia relating to a store coupon of a first predetermined value (figs. 6 & 7), the first card 15 having greater surface area than the second card 20 (fig. 1-C), the second card 20 having on both obverse and reverse sides indicia relating to a prepaid long-distance telephone calling card (fig. 1-C), the second card 20 having on the obverse indicia relating to a prepaid amount in a second predetermined value (e.g., \$10) (fig. 1-A), the second card 20 having on the reverse side a PIN

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code and a toll-free access telephone number (col. 3, lines 58-60); the method comprising the steps of: hanging the instrument on a hook; removing the instrument from the hook; separating the first card from the second card at the perforation; redeeming the first card for the first predetermined value in a purchase after the separating step (fig. 7); and placing at least one long-distance telephone call for no greater than any unused portion of the second predetermined value; the placing step further comprising dialing the toll-free access telephone number, and after the toll-free access telephone number is dialed, entering via dual-tone multifrequency tones the PIN code and a destination telephone number; wherein the placing step is inherently possibly performed more than once (i.e., depending on the time and place of the phone call); wherein the redeeming step is inherently performed prior to performing the placing step (i.e., for free activation) (col. 3, line 34 through col. 5, line 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2, 11, 20, 31, 42 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Najor et al (US 6183017 B1). The teachings of Kim have been discussed above.

Re claims 2, 11, 20, 31, 42 and 51: Kim discloses a barcode 17 disposed on the reverse side of the first card for tracking the card during mailing and handling process, but is silent with respect to a bar code relating to the first predetermined value, and wherein the step of redeeming the first card for the first predetermined value further comprises scanning the bar code on a bar code scanner.

Najor et al teaches relevant coupon information being encoded within a barcode 14, which is scanned by a barcode reader for redemption (figs. 2-3; col. 4, lines 35-57).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a conventional barcode including information relating to the coupon value of Najor et al into the system as taught by Kim in order to provide a time consumption system during purchasing process, wherein the coupon value being discount automatically upon scanning the barcode. Furthermore, such modification would have been an obvious engineering variation, well within the ordinary skill in the art, for encoding a coupon value into a barcode due to the fact that a barcode can be encoded with any desired information, and therefore an obvious expedient.

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7. Claims 7-9, 26-29 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Goade, Sr. (US 6109439 A). The teachings of Kim have been discussed above.

Re claims 7-9, 26-29 and 47-49: Kim has been discussed above, but is silent with respect to hanging instrument on a hook by the hook opening.

Goade, Sr. teaches a data card 22 being hanged on a hook 24 (fig. 2).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate hang the instruments of Kim on a hook in a retail store as taught by Goade, Sr. for intended use (i.e., for displaying the instruments to the customer in an organizing way that does not occupy a lot of space).

8. Claims 16-18, 37-40 and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Maritzen et al (US 6595342 B1). The teachings of Kim have been discussed above.

9. Re claims 16-18, 37-40 and 56-58: Kim has been discussed above, but is silent with respect to hanging instrument on a hook by the hook opening.

Maritzen et al the user purchases an open mode pre-paid phone card off the rack at a retail outlet, uses the card in open mode until the pre-paid value expires, then disposes of the card.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate store the

instruments of Kim on a rack in a retail store as taught by Maritzen et al for intended use (i.e., for displaying the instruments to the customer in an organizing way that does not occupy a lot of space).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents Longtin (US 5427832 A); Taskett (US 5762376 A); Goade, Sr. (US 5921584 A); Clapper, Jr. (US 5928082 A); Ramsberg et al (US 5958174 A); Carson (US 6028920 A); McCannel (US 6173901 B1); O'Neil (US 6226364 B1); Cremonese (US 6375080 B1); Blank (US 6588658 B1); Maritzen et al (US 6595342 B1); Malone (US 6640974 B2); Klure (US 6715795 B2); Smith (US 7000844 B1); Whitaker (US 7083086 B2) and Algiene (US 7063255 B2) to are cited as of interest and illustrate a similar structure to PREPAID LONG-DISTANCE TELEPHONE CALLING CARD WITH SEPARABLE COUPON.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Uyen-Chau N. Le
Primary Examiner
Art Unit 2876

September 18, 2006